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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) FSF-031421	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number 10/635,486		Filed August 7, 2003
	First Named Inventor Tomoyuki Ohzeki		
	Art Unit 1752		Examiner Thorl Chea
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 52,053</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Tomoyuki OHZEKI

Appln. No.: 10/635,486

Confirmation No.: 1098

Filed: August 7, 2003

For: PHOTOTHERMOGRAPHIC MATERIAL

Docket No: FSF-031421

Group Art Unit: 1752

Examiner: Thorl Chea

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

**1. Introduction**

Applicant submits the following arguments in support of the Pre-appeal Brief Request for Review. Applicant submits that there is at least one legal deficiency and at least one factual deficiency in the rejections. The legal deficiency lies in the examiner's failure to consider a process limitation found in claim 1 (the only independent claim). The factual deficiency is based on the examiner's failure to cite any reference that teaches the above-mentioned process limitation of claim 1. Because the legal and factual deficiencies involve the process limitation of claim 1, claim

1 is reproduced below:

1. A photothermographic material comprising a photosensitive silver halide, a reducing agent for reducing silver ions, a binder and a non-photosensitive organic silver salt, wherein the photosensitive silver halide has a silver iodide content ranging from 40 mol% to 100 mol%, and has a particle size ranging from 5 nm to 80 nm, and wherein the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed, such that the non-photosensitive organic silver salt includes the photosensitive silver halide.

## **2. Legal Deficiency**

In the first Office action the claims were rejected in Paragraphs 3, 4, 5, 6, 7, 8 and 9 under 35 USC 102(e) or 103(a). In each of the rejections, the examiner took the position that Applicant's process limitation results in a product that is indistinguishable from the products of the prior art. Applicant understands that when an examiner takes that position, the burden shifts to the applicant to show that the claimed process step(s) results in a product that is patentably distinct from the product of the cited prior art.

In order to distinguish the product of the present invention from that

of the prior art, Applicant submitted a declaration under 37 CFR 1.132 (response to first Office action). The declaration provided evidence in the form of photomicrographs (Figures 1-3) showing the substantial difference in microstructures formed in the final product depending on the method of preparation of the photothermographic material. Thus, Applicant showed “manufacturing process steps...[that] impart distinctive structural characteristics to the final product” In re Garnero, 412 F2d 276, 279 (CCPA 1979). Consequently, the burden shifted to the examiner to assess the claimed product in view of the process limitation.

However, even after Applicant submitted the declaration evidence, the examiner issued his final rejection in which the substantive rejections were identical to those of the first Office action. The examiner maintained the position that the instant product claims were unpatentable even though the prior art products were admittedly made by different processes (see final rejection, paragraphs 3, 4, 5, 6, 7, 8 and 9). Thus applicant asserts that there was a legal error on the part of the examiner in failing to consider the process limitations of the claims.

### **3. Factual Deficiency**

In the final rejection, paragraphs 3, 4, 5 and 6 involve rejections in which the primary reference is US Patent No. 6,143,488 to Uytterhoeven. As admitted by the examiner, Uytterhoeven fails to teach or suggest a “non-photosensitive organic silver salt... prepared in the presence of a photosensitive silver halide which has be preformed” (claim 1). Rather, Uytterhoeven teaches Method C of the declaration, which is a conversion method involving partially converting an organic silver salt to a silver halide. The resultant microstructure is shown in Figure 3 of the declaration. The clumps of silver halide grains on the organic silver salt crystals of Figure 3 stand in stark contrast to the well-dispersed silver halide grains and organic silver salt particles of Figure 2 (the product of the present invention).

Similarly, in Paragraph 7 of the final rejection, the claims are rejected over US Patent Publication No. 2003/0194659 to Ohzeki; in Paragraph 8, the claims are rejected over US Patent Publication No. 2003/0207216; in Paragraph 9, the claims are rejected over US Patent Publication No. 2003/0235794. Again, as admitted by the examiner, these references do not teach or suggest a “non-photosensitive organic silver salt [that] is prepared in the presence of the photosensitive silver halide which has been preformed”

(claim 1).

Instead, all of these references employ Method A of the declaration, which is a method of mixing a preformed silver halide with a separately prepared organic silver salt in an organic solvent. Method A results in the unsatisfactory microstructure of Figure 1, which includes aggregates of silver halide grains and silver salt particles. This is in contrast to the well-dispersed silver halide grains and organic silver salt particles of the present invention (Method B) as shown in Figure 2 of the declaration. Thus applicant asserts there is a factual error in the final rejection in that the claimed method limitation is not taught or suggested in any of the references.

In view of the foregoing remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "Sheldon J. Moss". The signature is written in a cursive style with a horizontal line underneath the name.

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